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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

CRISTINE MELO)
Plaintiff,) Case No. 3:19-cv-05449-CRB
v.)
FRIDA KAHLO CORPORATION, a) PLAINTIFF'S NOTICE OF MOTION
Panamanian corporation, and FRIDA) AND MOTION FOR PRELIMINARY
KAHLO INVESTMENTS, S.A., a) INJUNCTION
Panamanian corporation,)
Defendant.) HEARING: April 17, 2020
) Time: 10:00 am
) Judge: Hon. Judge Charles R. Breyer
) Rm: 6 (17th Floor)
)
)

PLAINTIFF'S NOTICE OF MOTION AND MOTION FOR PRELIMINARY
INJUNCTION

NOTICE OF MOTION

TO ALL PARTIES AND ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that on April 17, 2020 at 10:00 AM, before the Honorable
Charles R. Breyer of the United States District Court for the Northern District of California,
Plaintiff Cristine Melo does hereby and will move this Court for a preliminary injunction,

1 enjoining Defendants from issuing any further notices of infringement for Plaintiff's artwork.

2 This motion is based on this motion, the accompanying memorandum of points and
3 authorities, Ms. Melo's Second Amended Complaint, all supporting documents thereto, and papers
4 on file in this matter, and such arguments as may be made.

5 PLEASE FURTHER NOTE, the April 17, 2020 date was agreed on by the Parties as
6 requested by this Honorable Court during the February 7, 2020 hearing.

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8 *Rachael D. Lamkin*
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NORTHERN DISTRICT OF CALIFORNIA

CRISTINE MELO)
Plaintiff,) Case No. 3:19-cv-05449-CRB
v.)) PLAINTIFF'S MOTION FOR A
FRIDA KAHLO CORPORATION, a) PRELIMINARY INJUNCTION
Panamanian corporation, and FRIDA)
KAHLO INVESTMENTS, S.A., a) HEARING: April 17, 2020
Panamanian corporation,) Time: 10:00 am
Defendant.) Judge: Hon. Judge Charles R. Breyer
) Rm: 6 (17th Floor)
)

PLAINTIFF'S MOTION FOR A PRELIMINARY INJUNCTION

Pursuant to Civil L.R. 65-2, Plaintiff Cristine Melo respectfully moves this Court for an Order enjoining Defendants from issuing further intellectual property infringement takedown notices for Ms. Melo's artwork. If the Court declines this request, Ms. Melo respectfully requests an Order ceasing Defendants' issuance of foreign trademarks against Ms. Melo's artwork and ceasing issuance of takedowns for products for which Defendants have no United States trademark registrations.

1 **I. INTRODUCTION**

2 Ms. Cristine Melo is an American artist of Brazilian birth, living in this District. (Second
3 Amended Complaint (“SAC”), ¶2.) Ms. Melo is a person of limited means who supports herself
4 exclusively through commissions and sales of her artwork. (*Id.*, at ¶18.)

5 Ms. Melo has been painting portraits of the famed Mexican painter Frida Kahlo for years,
6 long before the formation of the Frida Kahlo Corporation and before any trademarks were filed for
7 the name “Frida Kahlo” by any person or entity. (*Id.*, at ¶16.) Ms. Melo sells her hand-painted,
8 fine art portraits of Frida Kahlo on eBay and digitized versions of her hand-painted portraits on
9 Pay On Demand (POD) sites such as Redbubble and Zazzle. POD sites allow artists such as Ms.
10 Melo to offer original artworks to consumers, who select her artwork and marry said art to a
11 product (e.g., jewelry or a cell phone case). The art is then placed on the product for shipment to
12 the customer.

14 The Frida Kahlo Corporation was created by a wealthy man named Carlos Dorado who
15 admits to conning Frida Kahlo’s family “like a used car salesman” into assigning to him their
16 trademark registrations for “Frida Kahlo”. (*Id.*, at ¶20.) FKC owns roughly a dozen trademark
17 registrations for “Frida Kahlo” in product categories such as tequila and cigars. (*Id.*, at ¶24.)
18 FKC does not own US trademark registrations for the great majority of products offered on POD
19 sites. For example, FKC has no registrations for “Frida Kahlo” for jewelry or watch bands or cell
20 phone cases. (*Id.*, at ¶¶174-75.) Undaunted, in order to improperly capture products for which
21 FKC has not been able to secure US registrations, FKC submits foreign trademarks (e.g., Chinese
22 and European registrations) to the US platforms. (*Id.*, at ¶¶142-148.) Foreign trademark
23 registrations are not enforceable in the United States. *See Person’s Co. v. Christman*, 900 F.2d
24 1565, 1568-69 (Fed. Cir. 1990) (“The concept of territoriality is basic to trademark law; trademark
25 rights exist in each country solely according to that country’s statutory scheme.”). However,
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1 because of factors such as the volume of takedowns and the liability associated with failing to
2 remove, the platforms appear to be simply accepting the foreign registrations. (See SAC, ¶236.)

3 FKC has been taking down Ms. Melo's artwork for eight (8) years, across several
4 platforms, including Zazzle, Etsy, and Redbubble. (*Id.*, at ¶7.) But Ms. Melo's use of the name
5 "Frida Kahlo" to describe her artwork depicting "Frida Kahlo" is not brand identifying, *i.e.*, not
6 trademark use. And after eight (8) years of suffering FKC's improper takedowns, FKC finally
7 agrees with Ms. Melo:

- 9 • "Defendants agree that Melo did not infringe on their trademarks relating to the five
10 takedowns."
- 11 • "Defendants agreed that Melo's artwork did not infringe."
- 12 • "Defendants have agreed that Melo's artwork does not constitute unauthorized trademark
13 use of Defendants' trademarks."

14 (SAC, ¶¶163-168.)

15 These admissions notwithstanding, on the exact same day that FKC filed its Motion
16 admitting that Ms. Melo's artwork does not infringe, FKC issued yet another improper takedown
17 notice to Redbubble, resulting in the removal of four (4) more of Ms. Melo's portraits. (SAC,
18 ¶¶162-163.) FKC's attempt to divest this Court of jurisdiction by admitting that Ms. Melo's
19 artwork does not infringe does nothing to remedy their past improper takedowns, applies only to
20 Redbubble, does nothing to reinstate Ms. Melo's work on other platforms such as Zazzle, and fails
21 to remedy the very real harm of Ms. Melo being permanently banned from the platforms due to the
22 platforms' Repeat Infringer Policies. (See SAC, ¶¶136-37,169,204,226,236.)

23 Further, FKC's promise to cease removing Ms. Melo's art appears to only apply to Ms.
24 Melo's Redbubble store. On Zazzle, for example, Zazzle continues to automatically remove Ms.
25 Melo's artwork based on instructions from FKC. (SAC, ¶¶196-203.) Indeed, FKC has instructed
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1 Zazzle to remove any and all artwork that references Frida Kahlo. (SAC, ¶¶171,175,184.)

2 Ms. Melo respectfully seeks an Order requiring FKC to cease all takedown efforts against
3 Ms. Melo's artwork during the pendency of this litigation. If this Honorable Court declines, Ms.
4 Melo respectfully asks that this Court issue an Order mandating that FKC (1) immediately cease
5 the use of foreign trademarks to remove Ms. Melo's artwork from platforms; and; (2) immediately
6 cease issuing takedowns for products for which FKC has no US trademark registrations.

7 **II. LEGAL AUTHORITY**

8 A preliminary injunction should issue where the plaintiff establishes that “[she] is likely to
9 succeed on the merits, that [she] is likely to suffer irreparable harm in the absence of preliminary
10 relief, that the balance of equities tips in his favor, and that an injunction is in the public interest.”
11 *Le Van Hung v. Schaaf*, No. 19-cv-01436-CRB, 2019 U.S. Dist. LEXIS 68867, at *8-9 (N.D. Cal.
12 Apr. 23, 2019) (*citing Rodriguez v. Robbins*, 715 F.3d 1127, 1133 (9th Cir. 2013)). The likelihood
13 of success on the merits is the most important factor; if a movant fails to meet this threshold
14 inquiry, the court need not consider the other factors. *Id.* (*quoting Disney Enterprises, Inc. v.*
15 *VidAngel, Inc.*, 869 F.3d 848, 856 (9th Cir. 2017) (quotation marks removed)). Moreover, “a
16 preliminary injunction is customarily granted on the basis of procedures that are less formal and
17 evidence that is less complete than in a trial on the merits.” *Id.* (*quoting Univ. of Texas v.*
18 *Camenisch*, 451 U.S. 390, 395, 101 S. Ct. 1830, 68 L. Ed. 2d 175 (1981)).

19 **III. A PRELIMINARY INJUNCTION SHOULD ISSUE**

20 **A. Ms. Melo Is Likely to Succeed on the Merits**

21 **i. FKC Admits Ms. Melo Does Not Infringe**

22 Ms. Melo is likely to prevail on her Non-Infringement claim. (See SAC, Count II, ¶¶77-
23 90.) First and foremost, FKC admits that Ms. Melo's use of Frida Kahlo's name is “not brand
24 identifying” use; *i.e.*, Ms. Melo does not use “Frida Kahlo” as a trademark but merely to describe
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1 the subject of her work. (SAC, ¶¶163-168.) Because FKC admits that Ms. Melo's use of Frida
2 Kahlo is not "brand identifying," Ms. Melo is likely to prevail on her non-infringement claim.

3 **ii. Ms. Melo is Likely to Prevail on Her Intentional Interference Claim**

4 Ms. Melo's likelihood of prevailing on her non-infringement claim is sufficient to support
5 prong one of the preliminary injunction test. *See Dennis v. Wells Fargo Bank, NA*, No. C 10-2328
6 PJH, 2010 U.S. Dist. LEXIS 82512, at *2 (N.D. Cal. July 15, 2010). But separately and equally
7 supporting a preliminary injunction, Ms. Melo can also establish a likelihood of prevailing on her
8 intentional interference claim. (SAC, Count VI, ¶¶126-211.)

9
10 In 2010, Carlos Dorado, on behalf of FKC, wrote to Zazzle and accused Zazzle of selling
11 products that violate FKC's intellectual property. (*Id.*, at ¶180.) In settlement of that dispute,
12 Zazzle agreed to take down all references to Frida Kahlo in the title or search terms for any
13 product, regardless of whether the use is actually infringing and regardless of whether FKC
14 actually holds a mark covering said product. (*Id.*, at ¶¶170,180-84.) Both of these demands are
15 remarkable. First, a blanket ban on any use of "Frida Kahlo" in titles and search terms is
16 unquestionably improper; the great bulk of such use is non-infringing. *See Playboy Enters. v.*
17 *Welles*, 279 F.3d 796, 801 (9th Cir. 2002). Further, FKC—at best—owns trademark registrations
18 in a limited number of categories, covering a limited number of goods. FKC has no right to block
19 the use of Frida Kahlo for products for which it has no trademark registrations. *Levi Strauss & Co.*
20 *v. Blue Bell, Inc.*, 778 F.2d 1352, 1354 (9th Cir. 1985) ("registration constitutes *prima facie*
21 evidence of a protected interest with respect to the good specified in the registration only.")
22
23 Regardless, FKC has been executing on FKC's instructions for a decade. (SAC, ¶183.)

24
25 In 2017, Zazzle, at FKC's instruction, took down Ms. Melo's "Frida Kahlo With Birds"
26 apron, *i.e.*, an offering of her painting for Frida Kahlo with Birds to be placed on an Apron. There
27 is nothing about the phrase "Frida Kahlo With Birds" that is brand identifying; it is identical to use
28

1 the FKC had already stated was not infringing use. As part of its takedown, Zazzle suggested that
2 Ms. Melo join the co-branded FKC-Zazzle “FanMerch” program. Both on principle and because
3 Ms. Melo must set her royalty level far above the mandatory 10% royalty of the FanMerch
4 program to make even a modest living, Ms. Melo refused. (*Id.*, at ¶¶188,196-199.)

5 In December 2020, Zazzle, at FKC’s instruction, removed several more of Ms. Melo’s
6 artworks, each again non-infringing and for product categories for which FKC has no US
7 registrations, *e.g.*, coffee mugs. (*Id.*)

8 In 2019, FKC through its agent Red Points, took down ten (10) of Ms. Melo’s artworks,
9 asserting foreign trademarks, including a Chinese mark covering the name Frida Kahlo in Chinese.
10 (*Id.*, at ¶¶139-167.)

11 In order to prevail on her intentional interference with prospective business advantage
12 claim, Ms. Melo must plead and prove: (1) an economic relationship between the plaintiff and
13 some third party, with the probability of future economic benefit to the plaintiff; (2) the
14 defendant’s knowledge of the relationship; (3) intentional acts on the part of the defendant
15 designed to disrupt the relationship; (4) actual disruption of the relationship; and (5) economic
16 harm to the plaintiff proximately caused by the acts of the defendant.” *Korea Supply Co. v.*
17 *Lockheed Martin Corp.*, 29 Cal. 4th 1134, 1153 (2003). Ms. Melo has plead each of these
18 elements and is likely to prevail on the claim.

19 FKC knew of Ms. Melo’s relationship with the platforms because FKC submits the
20 takedowns through the actual platforms and the takedowns occur after a review of Ms. Melo’s
21 offerings on said platforms.

22 FKC’s wrongful acts include: (1) employing the platforms’ takedown procedures for non-
23 infringing uses; (2) employing the platforms’ takedown procedures against products for which it
24 holds no US registrations; (3) asserting foreign trademarks against US based artists such as Ms.
25

1 Melo;¹ and (4) continuing to remove Ms. Melo’s artwork after promising said conduct would
2 cease. (SAC, ¶¶126-211.)

3 FKC committed these acts knowing that the platforms would remove Ms. Melo’s offerings,
4 indeed that is the entire purpose of the takedown notices. FKC was successful and Ms. Melo was
5 financially harmed. (*Id.*)

6 Thus, Ms. Melo’s likelihood of prevailing on her intentional interference claims provides a
7 second, independent basis under prong one of the preliminary injunction calculus.
8

9 **iii. Ms. Melo is Likely to Prevail on Her Nominative Fair Use Claim**

10 Artists such as Ms. Melo have been creating portraits of Frida Kahlo for decades prior to
11 the formation of the Frida Kahlo Corporation. (SAC, ¶¶61-64, 229-230.)

12 Ms. Melo’s use of “Frida Kahlo” to describe her portraits of Frida Kahlo is quintessential
13 nominative fair use. The doctrine “forbids a trademark registrant to appropriate a descriptive term
14 for his exclusive use and so prevent others from accurately describing a characteristic of their
15 goods.” *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

16 Indeed, “[t]rademarks are part of our common language, and we all have some right to use
17 them to communicate in truthful, non-misleading ways.” *Toyota Motor Sales, U.S.A., Inc. v.*
18 *Tabari*, 610 F.3d 1171, 1185 (9th Cir. 2010). Ms. Melo’s use of Frida Kahlo’s name to describe
19 her artwork featuring Frida Kahlo is protected by the nominative fair use doctrine; FKC’s
20 trademark registrations cannot interfere with Ms. Melo’s Constitutionally protected right to engage
21 in truthful communications with the public. *Toyota Motor Sales*, 1177.

22
23 In cases where a nominative fair use defense is raised, courts ask whether: (1) the product
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26 ¹ *Andersen Tax LLC v. Laffont-Reveilhac*, No. 17-cv-01311-EMC, 2017 U.S. Dist. LEXIS 93298,
27 at *2 (N.D. Cal. June 16, 2017); *Ingenohl v. Olsen & Co.*, 273 U.S. 541, 544 (1927) (“A trade-
28 mark started elsewhere would depend for its protection in Hongkong upon the law prevailing in
Hongkong and would confer no rights except by the consent of that law.”) (Holmes, J.)

1 was readily identifiable without use of the mark; (2) defendant used more of the mark than
2 necessary; or (3) defendant falsely suggested she was sponsored or endorsed by the trademark
3 holder. *Toyota Motor Sales*, 1175-76; *see also Playboy Enters. v. Welles*, 279 F.3d 796, 801 (9th
4 Cir. 2002).

5 Here, Ms. Melo's artwork would not be readily identifiable (nor searchable) without the
6 use of FKC's alleged "Frida Kahlo" marks. As in *Playboy*, "There is no other way that Ms.
7 [Melo] can identify or describe . . . her services without venturing into absurd descriptive phrases."
8 *Playboy*, at 802. To describe her artwork as depicting "the famous Mexican painter with a
9 mustache and unibrow" "would be impractical as well as ineffectual[.]" *Id.* In fact, Ms. Melo
10 would be greatly disadvantaged in the marketplace if she were forced to describe her work thusly.
11

12 Ms. Melo used only as much of the "Frida Kahlo" mark as is necessary.

13 And, Ms. Melo never falsely suggested she is sponsored or endorsed by FKC. In fact, Ms.
14 Melo repeatedly makes clear that she is the creator of the portraits. (SAC, ¶¶30, 87.)

15 Thus, Ms. Melo's likelihood of prevailing on her nominative fair use claim provides a
16 third, independent basis under prong one of the preliminary injunction calculus.
17

18 **B. Ms. Melo is Likely to Suffer Irreparable Harm**

19 FKC's repeated takedowns are extremely damaging to Ms. Melo in a manner that a money
20 judgment at the end of this litigation will not absolve.

21 First, the platforms each have a policy that they will remove artists from their platform in
22 case of repeated notices of infringement. For example, Redbubble's stated policy:
23

24 REPEAT INFRINGER POLICY: It is Redbubble's policy, in appropriate
25 circumstances, to disable and/or terminate the accounts of users who repeatedly
infringe or are repeatedly charged with infringing the copyrights, trademark
rights, other intellectual property rights or publicity rights of others.

26 (SAC, ¶136; *see also id.*, at ¶¶169,204.)
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1 The platforms' Repeat Infringer Policies are all secret; no one external to the platforms
2 knows how many notices will trigger permanent termination. But at some point Ms. Melo will get
3 terminated and she will lose the ability to support herself.

4 Second, the algorithms on these platforms are such that the type and number of artworks
5 one has to offer creates cascade effects that brings customers to an artist's storefront. (SAC,
6 ¶210.) Thus, each portrait that is removed effects when and if her other works will be viewable
7 given the platform's algorithms. (*Id.*).

8 These harms are not recoverable in money damages at the end of this litigation.

9

10 **C. The Balance of Equities Weights Heavily in Ms. Melo's Favor**

11 Here, there can be no question that the balance of equities favor Ms. Melo. Ms. Melo is an
12 artist living on limited means whose sole support is her artwork. (SAC, ¶18.) The takedowns
13 issued by FKC have all but eliminated Ms. Melo's income and threaten to permanently suspend
14 her from the platforms. Conversely, whether or not Ms. Melo sells her artwork will have no effect
15 on FKC; her sales are a drop in their oceanic bucket.

16 Materially, FKC has employed substantial wrongful conduct in its takedown practices,
17 including (1) the unlawful assertion of foreign marks; (2) the removal of products for which FKC
18 owns no cognizable intellectual property rights; and (3) the use of the takedown system for force
19 artists in Zazzle's Fanmerch program.

20

21 **D. The Public Interest Weighs In Favor of an Injunction**

22 The public interest is best served when intellectual property is properly enforced. *See*
23 *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1354 (Fed. Cir. 2005); *Nestier Corp.*
24 *v. Menasha Corporation-Lewisystems Div.*, 739 F.2d 1576, 1581 (Fed. Cir. 1984).

25 Further, the public has an interest in restraining a purported intellectual property rights
26 holder's effort to unfairly assert a right beyond the scope of its grant. *See Mallinckrodt, Inc. v.*
27

Medipart, Inc., 976 F.2d 700, 703-04 (Fed. Cir. 1992).

Further, the principles of comity and sovereignty mandate that foreign trademarks not be enforced against US artists.

Moreover, the public has an undeniable interest in representations of Frida Kahlo, and FKC should not be the only entity permitted to create said representations. Especially where, as here, hundreds if not thousands of California artists are being affected. (SAC, ¶¶225-238.)

Finally, there is also public interest in due process. *Sturgis v. Goldsmith*, 796 F.2d 1103 (9th Cir. 1986); *Bustamante v. Eyman*, 456 F.2d 269, 274 (9th Cir. 1972); *In re Frantz*, 534 B.R. 378, 390 (Bankr. D. Idaho 2015). Platforms are rapidly becoming a requisite storefront for most artists. These platforms have also become, unfortunately, the new courts of law. FKC was able to obtain multiple injunctions from the platforms' automated systems without satisfying any of the elements required for an injunction in a court of law. That FKC can obtain *ex parte* injunctions, asserting unenforceable foreign rights, absent any mechanism to defend is deeply troubling and violative of Ms. Melo's due process.

IV. CONCLUSION

Trademarks do not exist to protect FKC, or any alleged rights holder. *Enter. Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 330 F.3d 1333, 1339 (Fed. Cir. 2003) (quoting H.R. Rep. No. 76-944, at 3 (1939).) They exist to protect the consumer from confusion as to the source of goods. *Id.* Here, the *sine qua non* of the Lanham Act isn't triggered as Ms. Melo's use of Frida Kahlo is not brand identifying use. No trademark infringement notices against Ms. Melo should stand and no more should issue.

An order from this Honorable Court, that merely holds FKC to its own admissions, that Ms. Melo does not infringe is respectfully requested. In the alternative, Ms. Melo requests an order mandating that FKC stop using foreign marks to remove Ms. Melo's artwork from platforms,

1 and stop issuing takedowns for products for which it owns no US registrations.
2

3 Respectfully submitted,
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5 *Rachael D. Lamkin*
6 Rachael D. Lamkin
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8 *Attorneys for DJ Plaintiff*
9 *Cristine Melo*
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13 **CERTIFICATE OF SERVICE**

14 The following document will be filed with the Court's ECF system on today's date,
15 02/18/20202, and thereby served upon and available to counsel for Defendants.
16

17 **NOTICE AND MOTION FOR PRELIMINARY INJUNCTION**
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19

20 Respectfully submitted,
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22 *Rachael D. Lamkin*
23 Rachael D. Lamkin
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